## REMARKS/ARGUMENTS

The Office Action has been carefully considered. Claims 1, 3, 7-8, 15, 17-18, 26, 28-31, 53, 55, and 59 are currently amended. Claims 9-12, 14, 32-36, 38, and 51-52 are withdrawn. Claims 13, 37, and 39-50 are canceled. Claims 1-12, 14-36, 38, and 51-60 are pending. In the Office Action, claims were rejected in the following manner.

Claims 1-8, 15-31 and 39-50 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Claims 1-8 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Claims 1-8, 15-31, 39-50 and 53-60 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Mages et al's US Patent No. 6,185,306 (hereinafter "*Mages*") in view of Hazra's US Patent No. 6,510,553 (hereinafter "*Hazra*").

### *35 U.S.C. § 101 Rejections*

Claims 1-8, 15-31 and 39-50 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Claim 1 has been amended to specify that the electronic device receives the first and second data files and interleaves them to assemble a portion of the media file. Thus, the method of Claim 1 and its dependent Claims 2-8, are tied to a particular apparatus (the electronic device) and claim statutory subject matter under 35 U.S.C. § 101.

Claim 15 has been amended to claim a media play apparatus comprising several physical "things," including a processor, a memory storing instructions for performing a statutory process, and a wireless transceiver. Thus, Claim 15 and its dependent Claims 16-25 recite statutory subject matter under 35 U.S.C. § 101.

Claim 26 has been amended to claim a media playback apparatus comprising, *inter alia*, first and second reception means for receiving data files from remote computing devices. According to Applicant's knowledge of the art, such reception means for receiving data files from remote computing devices cannot be implemented purely in software. Thus, although the claimed first and second reception means may include software, the first and second reception means necessarily have a tangible computing component to receive an incoming signal and transform it into a data file. Accordingly, Applicant respectfully submits that Claim 26 and its dependent Claims 27-31 recite statutory subject matter under 35 U.S.C. § 101.

Bratton, Timothy – DELIVERING       11       Attorney Docket No. REAL-2007115
MEDIA DATA TO PORTABLE                                         (RN113)
COMPUTING DEVICES

Claims 39-50 have been canceled without prejudice, so their rejections are moot. Applicant reserves the right to pursue the subject matter of some or all of Claims 39-50 in a continuation application.

### *35 U.S.C. § 112, Second Paragraph Rejections*

Claims 1-8 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Claim 1 has been amended to clarify that the second data file is received by the electronic device from the second computing device. Applicant respectfully submits that Claim 1 and dependent Claims 2-8 particularly point out and distinctly claim subject matter that Applicant regards as the invention. Therefore, Applicant respectfully submits that Claims 1-8 are allowable under 35 U.S.C. § 112, second paragraph.

### *35 U.S.C. § 103(a) Rejections*

Claims 1-8, 15-31, 39-50, and 53-60 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Mages* in view of *Hazra*. Applicant respectfully traverses the rejection. Claims 39-50 have been canceled without prejudice, so their rejections are moot. Although Applicant believes that Claims 1-8, 15-31, and 53-60 were patentable as previously drafted, Applicant has nonetheless amended Claims 1, 3, 7-8, 15, 17-18, 26, 28-31, 53, 55, and 59 to make abundantly clear that *Mages* in view of *Hazra* fails to teach or even suggest each element recited therein.

For example, amended Claim 1 recites as follows:

A method of assembling a media file for playing in an electronic device, comprising:
    receiving by the electronic device a first data file from a first computing device via a first communication channel, wherein **the first data file** is unusable as a media file and **comprises a first multiplicity of encoded-media-data portions from a first multiplicity of non-contiguous intervals spaced throughout the media file**;
    receiving by the electronic device a second data file from a second computing device via a second communication channel, wherein **the second data file is unusable as a media file and comprises a second multiplicity of encoded-media-data portions from a second multiplicity of non-contiguous intervals spaced throughout the media file**; and
        interleaving, according to a predetermined algorithm, portions of **encoded media data from said first data file and said second data file to assemble a renderable contiguous portion of the media file** by the electronic device.

Thus, Claim 1 claims a specific and sophisticated method of assembling a contiguous portion of a media file by interleaving portions of two data files according to a predetermined

algorithm. The first data file is not usable as a media file and "comprises a first multiplicity of encoded-media-data portions from a first multiplicity of non-contiguous intervals spaced throughout the media file." The second data file is also not usable as a media file and "comprises a second multiplicity of encoded-media-data portions from a second multiplicity of non-contiguous intervals spaced throughout the media file."

In the Application, at least Figs. 2A-C and associated text provide support for the amended claim language. In particular, Fig. 2B shows a second multiplicity of encoded media portions 203 spaced throughout the media file 201 at non-contiguous intervals. Fig. 2C shows a second data file 209 comprising the multiplicity of encoded media portions 203 and a first data file 205 comprising a first multiplicity of non-contiguous encoded media portions (not numbered) that were in the intervals between portions 203 in the media file 201. As stated at page 18, lines 17-20, "[t]he removed portions 203 may include... other portions of the file selected according to a predetermined formula. For example, one formula may call for the removal of every X bytes...."

At page 26, lines 14-22, the Application describes the process of assembling a portion of a media file using the first and second data files: "the EM file's instructions may indicate where media data has been removed from the RM file, how much media data has been removed, and where in the EM file the removed media data may be found." Thus, comparing this disclosure with the first and second data files illustrated in Figure 2C, it is apparent that a portion of the original media file may be assembled by placing a portion from the first data file adjacent to a portion from the second data file, adjacent to a portion from the first data file, adjacent to a portion from the second data file, and so on. In other words, a portion of the media file may be assembled by "interleaving" portions of encoded media data from the first and second data files.

By contrast, *Mages* teaches merely that content or a "HyperCD" may be "crippled" by "achieved by removing critical information such as the video-audio header, whereupon such video/audio data is rendered unreadable by the end-user's computer." Col. 6 lines 39-43. As characterized in the Office Action, *Mages* discloses that it is also possible to "cripple" a media file by means other than deleting the media file's header. As examples of such "means other than deleting the header," *Mages* discloses as follows:

> the file could be made a hidden file, with the trigger data from the host computer being a command to remove the hidden status. Alternatively, the video/audio file could have a changed extension, with the trigger data from the host computer being a command to change the extension. Moreover, the crippling of the

video/audio file may be achieved by the use of ZIP file, with the trigger data from the host computer being a command to UNZIP the data.

Thus, *Mages* discloses that a media file may be "crippled" in several simplistic ways: deleting the file's header, flagging the file as hidden, changing the file's extension, or compressing the media file into a ZIP archive. According to the Office Action's reasoning, the method of assembling a media file as claimed in Claim 1 "would be a predictable result" in light of *Mages's* disclosure that it is possible to "cripple" a media file by means other than deleting the media file's header, notwithstanding that none of *Mages's* alternative, simplistic crippling methods relate to removing portions of media data from the media file, as claimed.

Applicant respectfully submits that *Mages's* minimal disclosure about other methods of crippling a media file do not even come close to rendering Claim 1 obvious, even when *Mages* is considered in combination with *Hazra*, which teaches merely that an entire media file "may be authored as multiple independent streams." Col. 8 line 54-Col. 9 line 15.

Applicant respectfully submits that *Mages* and *Hazra*, alone or in combination, utterly fail to disclose the particular method of assembling a media file, as claimed in amended Claim 1.

In particular, *Mages* and *Hazra*, alone or in combination, fail to disclose "interleaving, according to a predetermined algorithm, portions of encoded media data from said first data file and said second data file to assemble a renderable contiguous portion of the media file," as claimed.

*Mages* and *Hazra*, alone or in combination, further fail to disclose "the first data file… comprises a first multiplicity of encoded-media-data portions from a first multiplicity of non-contiguous intervals spaced throughout the media file," and "the second data file… comprises a second multiplicity of encoded-media-data portions from a second multiplicity of non-contiguous intervals spaced throughout the media file."

For at least the reasons discussed above, Applicant respectfully submits that Claim 1 is allowable over the cited art. Independent Claims 15, 26, and 53 recite similar elements to those of Claim 1 and are allowable at least by similar reasoning.

Dependent Claims 2-8, 16-25, 27-31, and 54-60 are allowable at least by their dependency on allowable independent claims. In addition, Claims 2-8, 16-25, 27-31, and 54-60 recite additional patentable subject matter that is not taught or suggested by the cited art.

For example, Claim 7 claims "examining sequencing information in said second data file that describes where the second multiplicity of encoded-media-data portions should be

interleaved with the first multiplicity of encoded-media-data portions to assemble the contiguous portion of the media file." Applicant respectfully submits that *Mages* in view of *Hazra* fails to teach or even suggest this element. The Office Action asserts that *Mages* discloses "playing media files from two portions, each of which is unusable as a media file and each of which is delivered by a separate channel...." However *Mages* in view of *Hazra* fails to disclose 1) that the second data file includes sequencing information; 2) that the sequencing information describes where the second multiplicity of encoded-media-data portions should be interleaved with the first multiplicity of encoded-media-data portions; and 3) that the described interleaving assembles the contiguous portion of the media file, as claimed.

For at least the reasons discussed above, Applicant respectfully submits that Claims 1-8, 15-31, and 53-60 are allowable over the cited art. In addition, as discussed below, Applicant respectfully submits that Claims 1-8, 15-31, and 53-60 are further allowable because one of ordinary skill in the art would not have made the proposed combination of references.

**One of ordinary skill in the art would have had no motivation to combine *Mages* with *Hazra* in order to arrive at the invention claimed in Claim 1.**

According to the Office Action at 8, "[i]t would have been obvious to one of ordinary skill in the art to combine the teachings of Mages and Hazra motivated by the desire for a faster transmission, thus avoiding 'choppy' playing of media." This motivation is defective because one who was motivated to avoid choppy playback would have arrived at an invention other than a combination of Mages and Hazra.

For example, if one were motivated to avoid choppy playback, one might follow *Hazra's* teaching that "the author may choose to take the same video content and encode it with different encoding parameters (e.g., data rate, frame rate, video size), storing all the resultant streams in the same file. .... The client system may switch between the different available streams under conditions of changing bandwidth...." Col. 9 lines 3-10. However, if one of ordinary skill combined that process with the teachings of *Mages*, he or she would arrive at an invention other than that claimed in Claim 1, which is not directed towards switching between streams as bandwidth changes.

**One of ordinary skill in the art would have had no motivation to combine *Mages* with *Hazra* because *Hazra* teaches away from the inventions claimed in Claims 2, 16, 21-22, 27, and 54.**

In addition, one of ordinary skill seeking to solve the problems addressed by the inventions claimed in Claims 2, 16, 21-22, 27, and 54 would find no motivation to combine

*Mages* with *Hazra* because *Hazra* teaches away from the invention. *See* MPEP § 2145, paragraph X.D.1. (citing *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994)).

> A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be **discouraged** from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant. ... [I]n general, a reference will teach away if it suggests that the line of development flowing from the reference's disclosure is **unlikely to be productive of the result sought by the applicant.**

*In re Gurley*, 27 F.3d at 553 (emphasis added).

A reference that teaches away from a given combination may negate a motivation to modify the prior art to meet the claimed invention. *See, e.g., KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1739-40 (2007) (explaining that when the prior art teaches away from a combination, that combination is more likely to be nonobvious).

One of ordinary skill seeking to arrive at the inventions claimed in Claims 2, 16, 21-22, 27, and 54 would find no motivation to combine *Mages* with *Hazra* because *Hazra* teaches away from the solutions implemented by the inventions claimed in Claims 2, 16, 21-22, 27, and 54. According to the application, the claimed inventions are generally directed towards "streaming media to portable computing devices **without requiring maintenance of a wireless connection to the source of the streaming media** throughout playback" in order to "reduc[e] overall power consumption in [a] wireless device." *See* Abstract; ¶¶ [5-7]. Thus, one of ordinary skill would have been motivated to seek solutions that do not require continuous connections and that tend to prolong battery life.

By contrast, *Hazra* contemplates that a connection to the streaming media source **must be maintained while the media is playing**. *See, e.g.,* Col. 8 line 54-Col. 9 line 15. Thus, one of ordinary skill in the art would have been dissuaded from combining *Hazra* with *Mages* because *Hazra*'s teachings would have required a constant battery-draining connection, thereby thwarting his or her efforts to reduce overall power consumption.

Accordingly, one of ordinary skill in the art would not have been motivated to combine the cited references in order to arrive at the claimed invention. For this additional reason, Applicants respectfully assert that the Office Action has failed to state a *prima facie* case that Claims 2, 16, 21-22, 27, and 54 are obvious considering *Mages* in view of *Hazra*.

## CONCLUSION

For at least the reasons above, Applicant respectfully submits that all pending claims are allowable and requests that the Examiner permit these claims to proceed to issuance. Although additional arguments are believed to exist for distinguishing the cited documents, the arguments presented are believed sufficient to address the Examiner's rejections. Likewise, failure of the Applicant to respond to a position taken by the Examiner is not an indication of acceptance or acquiescence of the Examiner's position. Instead, it is believed that the Examiner's positions are rendered moot by the foregoing arguments, and it is therefore not believed necessary to respond to every position taken by the Examiner with which Applicant does not agree.

The Examiner is respectfully requested to contact the undersigned at the telephone number below if there are any remaining questions regarding this application.

We believe the appropriate fees accompany this transmission. If, however, insufficient fee payment or fee overpayment occurs, the amount may be withdrawn or deposited from/to AXIOS Law's deposit account. The deposit account number is 50-4051.

Respectfully submitted,

AXIOS LAW

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